REMARKS

In response to Examiner's Office Action of November 19, 2003, regarding the omission of arguments on 102(a)(e) for claims 1 and 4, Applicant is providing the attached analysis.

A. This section is in reference to Examiner's rejection of claim 1 under 35 USC 102(a)(e) for anticipation based on the Rao reference.

In regard to Applicant's clause (a), claim 1, the Examiner has cited the Rao column 2, lines 8-10 and column 4, lines 44-54, as will be copied and indicated herein below.

At column 2, lines 8-10, Rao states the following:

> New or updated utility algorithms may be transferred to the storage drive as needed or as they become available.

It is not understood how this statement on the transfer of utility algorithms would teach the first source software means providing SCSI firmware for a disk drive and servo SCSI firmware for positioning said disk drive. It should be indicated that there is no correlation as to the teaching here. Rao has only provided a broad generality with no implementing functionality.

Now, to quote the Rao column 4, lines 44-54, as follows:

> The SCSI controller board 202 controls the high level operations of the disk drive assembly while the drive controller board controls the low level tasks. The low level

> tasks controlled by the drive controller board 206 pertain to the physical operation to the disk drive including positioning of the disk drive head and electrical signals to the disk drive head used to read or write information, for example. Other commands which do not directly pertain to the rudimentary control and positioning of the disk heads, disk speed, etc., are considered high level commands and are processed by the SCSI controller board 202.

While Rao here does discuss positioning of the disk drive head, it should be seen that Applicant's clause (a) involves a first source software means providing SCSI firmware for a disk drive . . . . Rao does <u>not</u> specify such items.

Now, as to Applicant's claim 1, clause (b), the Examiner has cited the Rao reference column 6, lines 10-15 as copied herein below:

> The processing circuitry 230 includes a general purpose microprocessor which executes various algorithms which are stored in the erasable non-volatile memory 212. This microprocessor will require a memory for execution of the algorithm such as random access memory which is conveniently implemented as buffer A226 or buffer B228.

Here, it should be noted that Applicant's clause (b) provides for a central processing unit having software programmable selection means for choosing single or dual two-dimensional array means for temporary storing said SCSI firmware prior to placement into a target peripheral controller for said disk drive.

Again here, we should note that there is a minimal amount of correlation between the statement of Rao and the statements seen in clause (b) of Applicant's regarding selection means for single or dual two-dimensional array means.

Now, regarding Applicant's claim 1, clause (c) on which Examiner has cited Rao column 7, lines 33-41, which is copied herein below:

> For example, different algorithms may be stored in the erasable non-volatile memory 212 or other non-volatile memory within the SCSI controller board 202. The user has the ability to select different programs stored on the controller board and to select the parameters which control the operation of the utility programs executed in the storage drive assembly. Further, the invention includes the storage of a plurality of programs which perform the same function and the user selects which of the programs is to be used.

Again, Examiner should notice that Applicant's clause (c) involves means for temporarily storing different versions of said firmware until said target controller has been accessed to identify the proper version of software required. --- Again, it should be noted that Rao's statement of the ability to select different programs stored on a controller board does not correlate with the statements in Applicant's clause (c) which involve a need for the target controller to be accessed to identify the proper version of firmware required.

In regard to Applicant's claim 1 clause (d), Examiner has cited the Rao reference at column 2, lines 4-6 which is copied herein below:

> The storage drive will initially have default parameters for controlling the storage drive programmed in the erasable non-volatile memory.

Again, the Examiner should note the difference in Applicant's clause (d) which states means for checking the pre-existing firmware in said target controller to determine whether an updated firmware version will be required for a subsequent download. Note that the Rao reference required default parameters for controlling the storage drive programmed in erasable non-volatile memory.

Of course, there is considerable similarity in some of the operational functions involved, however, on overall definitions of Applicant's claims, it can be seen that the items

of the Rao reference do not correlate with a number of the claims clauses as developed by Applicant.

B. These next series of statements will involve Applicant's claim 4 and the various clauses thereof with respect to Examiner's references to the Rao reference.

Now, regarding Applicant's claim 4 clause (a), Examiner has cited the Rao reference, column 2, lines 8-10 which is copied herein below:

> New or updated utility algorithms may be transferred to the storage drive as needed or as they become available.

Here, we have a very broad, generalized statement with no real implementation or explanation of how these utility algorithms can be utilized.

Likewise, a reference to Applicant's clause (a) indicates a source software means for said SCSI firmware and SCSI servo firmware said source software means including:

> (a1) control data received from tape, disk, CD-ROM or the World Wide Web;

Here, it would appear there would be no warrant for the statements in Rao column 2, lines 8-10 which could correlate or cover the definitions stated in Applicant's clause (a).

In regard to Applicant's claim 4 clause (b), Examiner has cited the Rao reference column 4, lines 15-31, which is copied herein below:

> The computer 100 includes a central processing unit 102 which includes the necessary conventional components which are found in a personal computer such as an IBM compatible personal computer including a power supply, a microprocessor, RAM, ROM, and any other conventional components which are necessary. The CPU 102 includes a first peripheral device 104, such as a floppy disk drive, an optical disk, a tape drive, or any other peripheral device. There is also the storage drive assembly 106 which is illustrated in Fig. 2 as a disk drive assembly and discussed in detail below. However, the storage drive assembly can be any type of storage device such as a tape drive or any type of disk drive. The computer 100 further includes a monitor 108, a pointing device such as a mouse 110 and a keyboard 112. The CPU includes a modem (not illustrated) connecting to a phone line 114 which is used for downloading new microcode used to control the disk drive assembly 106.

Here, Rao has made a laundry list of the various computer components which are used, however, this will be seen not to correlate with Applicant's clause (b) involving central processing means for receiving said firmware from said source

software means and utilizing a memory means for separate storage areas for said SCSI firmware and for said servo SCSI firmware, wherein said central processing means includes: and here Applicant lists:

(b1) software means for recognizing a number of bytes;

(b2) means for selecting a buffer array size which most closely approximates the recognized number of bytes to be downloaded;

(b3) software inquiry means to said target controller to acquire identification information;

(b4) software means to determine from said identification information, what version of firmware will be downloaded to said target controller.

> Here, it should be noted that the laundry list supplied by Rao in column 4, lines 15-31 does not correlate to or cover the various aspects and functions recited in Applicant's clause (b).

In regard to Applicant's claim 4 clause (c), the Examiner has cited the Rao reference column 4, lines 41-44 which is copied herein below:

> The SCSI controller board 202 is connected to the host computer 100 through a SCSI cable having the appropriate connectors for attachment to the host computer and disk drive assembly.

In this regard of Applicant's clause (c), Applicant has no argument that the Rao reference may indeed teach a similar type of connection means.

In regard to Applicant's claim 4, clause (d), the Examiner has cited the Rao reference, column 5 lines 62-64, which is copied herein below as follows:

> The non-volatile memory 212 is illustrated as one element but a variation of the invention has this memory implemented using a plurality of memories.

In this case, Applicant has no quarrel with the idea of using a plurality of memories.

In regard to Applicant's claim 4, clause (e), the Examiner has cited the Rao reference column 5, lines 66 to column 6, line 2, which is copied hereinunder as follows:

> Also, completely new utilities and algorithms may be transferred from memory 212 from/to the host computer through the processor controller 10, buffer controller 220 and SCSI protocol controller 218.

Here, it should be noted that Applicant's clause (e) involves means to write said firmware from said first flash and said second flash PROMs onto a targeted peripheral controller for a disk unit.

Note here, that Rao is talking about the transfer of utilities and algorithms to a memory from the host computer through various other modules. Quite contrarily, it should be noted that Applicant's clause

(e) involves a means to write the firmware from said first flash and second flash PROMs onto a targeted peripheral controller for a disk unit, so there is a difference in functionality in what Rao is talking about when he mentions "utilities and algorithms may be transferred to memory 212 from the host computer through the processor controllers", etc. Applicant's clause (e) is a direct writing operation to a targeted peripheral controller for a disk unit.

Thus, as previously indicated in Applicant's remarks above, there are many similarities, but just as many differences involved in Applicant's system for efficiently downloading firmware.

On the subject of anticipation, a statement was made in the case of *Panduit Corporation v. Dennison Manufacturing Company*, recorded at 227 USPQ 831, in the Federal Circuit in 1985, where it was stated that:

> For a patent to be anticipated under Article 102, there must be present "in a single prior art disclosure of all the elements of a claimed invention arranged as in that claim".

In this regard, it should be stated that the single prior art reference of Rao does not disclose all of the elements and functional operations of Applicant's claims 1 and 4.

In the case of *Minnesota Mining & Manufacturing Company v. Johnson & Johnson Orthopedics, Inc.*, decided September 30, 1992, in the Court of Appeals for the Federal Circuit, and recorded at 24 USPQ 2d, p.1321, the Court stated as follows:

> Party asserting anticipation of patent claim under 35 USC 102 must demonstrate identity of invention, which in turn requires that each element of claim is found, either expressly or under principles of inherency, in a single prior art reference, or that claimed invention was previously known or embodied in a single prior art device or practice. Federal District Court's finding on issue of identity of invention is question of fact subject to review under clearly erroneous standard.

Here again, Applicant would state that the clauses of claims 1 and 4 of Applicant are not found in the Rao reference, as the Rao reference has been illustrated and stated.

In the case of *Code-Alarm, Incorporated v. Electromode of Technologies Corporation* (DC) Eastern District of Michigan, 7/28/92 as stated in the Index Digest of 26 USPQ 2d at p.208, as follows:

> Cited prior art patents do not anticipate patent and suit for vehicle security system, since no cited prior art patent is moveable in all planes of motion of patent in suit, including being rotatable around axis, without having position which defeats motion-sensing capabilities.

Here again, it should be indicated that the Rao reference certainly does not teach use of the World Wide Web, nor

does it teach the use of selecting single or multiple buffer memories, nor does it teach the selections of the proper formats to be downloaded.

In the case of *Deere & Company v. International Harvester Company*, as reported at 200 USPQ 150, the District Court of Southern Illinois indicated:

> Claim cannot be anticipated under 35 USC 102 unless all elements of claim are disclosed in a single prior art reference; anticipation cannot be shown by finding individual elements separately in prior art. (underlines added).

Again, Applicant would indicate that all elements of Applicant's claim are not disclosed in the single prior art reference to Rao.

This is further buttressed by the case of *Colt Industries Operating Corporation v. Index-Werke KG, Hahn & Tessky*, reported at 205 USPQ 990, in the District Court of the District of Columbia, as follows:

> There can be no anticipation under 35 USC 102(a) unless all of same elements are found in exactly same situation and united in same way to perform identical functions in a single prior art reference. (underlines added).

This is further buttressed by the case of *Grefco, Incorporated v. Kewanee Industries, Incorporated*, reported at 208 USPQ 218, in the District Court of Delaware, as follows:

> Prior art reference must teach every invention of patent to anticipate it, or disclose device substantially identical to that claimed under terms of patent; further, it must appear that every material element of claim in question was disclosed by a single prior art reference.

Another case of anticipation is involved in *Continental Oil Company v. Cole*, reported at 209 USPQ 361, in the Court of Appeals 5th Circuit, as follows:

> Anticipation defense derives principally from 35 USC 102(a); not only is that defense strictly technical one, but unless all of same elements or their equivalents are found in substantially same situation where they do substantially same work in same way, there is no anticipation.

In the case of *In re Mihalich*, decided October 20, 1992, and decided by the Court of Appeals, Federal Circuit, on p.1478 and reported on 25 USPQ 2d, p.205 as follows:

> Board of Patent Appeals and Interferences clearly erred in rejecting claims for thermally insulated beverage dispenser with two compartments as anticipated by prior art patent, since prior art patent does not expressly disclose "thermally conducting" partition element . . .

Applicant contends that the Rao reference cannot be said to teach each and every element of Applicant's claims and

does not teach that they function in the same situation and do the same work in the same way.

It is now respectfully requested that Examiner look at the existing claims as a "whole in their entirety" and not as merely having the same minimal correlation to the cited references in certain aspects.

Thus, Applicant would pray that Examiner recognize the distinguishing differences in Applicant's system and subsequently provide a timely Notice of Allowance for the extant claims.

Respectfully submitted,

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Patti S. Freddy

Date: December 10, 2003 Patti S Freddy